

Appl. No. : 09/804,509
Filed : March 12, 2001

REMARKS

Election of Species

The Examiner has required the election of an "ultimate species" of a) the instant colorant, B0 the instant gelation agent, c) the instant resin component and d) the instant solvent. The Applicant therefore elects the species described in Example 3 from Table 1, wherein the colorant is Carbon black, the gelation agent is Gel All D, the resin component is PVB2000L, Hilac 111, and Versamide 335, and the solvent is Tripropylene glycol monomethyl ether and Dipropylene glycol monomethyl ether.

Amendments to Claims

Claims 9-10, 12-17, 22, and 39-49 are currently pending. Claims 23-38 are canceled as they are drawn to non-elected species. New claims 40-49 are presented. Claims 9 and 22 are currently amended to make explicit what was implicit in the claims and therefore for reason unrelated to patentability. The amended and new claims are supported throughout the specification, for example in the original claims. No new matter has been added.

Definiteness of Claims

The Office rejected claim 22 under 35 USC 112, second paragraph, as being indefinite. The Office considered the phrase "wherein solvent is included at 20-80% by weight" to be indefinite because the entity of measure was not clear. The claim has been amended to include the phrase "in the solid composition". This amendment should make clear the claimed entity and therefore the claim should be allowed.

Patentability of the Present Invention

The claimed invention is directed to a solid composition which contains a mixture of at least two different specific solvents (see Amended Claim 9 and New Claim 40).

By this amendment, composition of the claimed invention does not contain a mixture consisting of "ethylene glycol monobutyl ether" and "dipropylene glycol monomethyl ether."

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Novelty and Non-obviousness over Fukuo et al (U.S. 6,203,910)

The office has rejected claims 9, 12-17, 22 and 39 under 35 USC 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Fukuo et al. (U.S. 6,203,910). The rule according to MPEP 2131 is that to anticipate a claim, the reference must teach every element of the claim. Fukuo does not disclose a solid composition which contains a mixture of at least two different specific solvents defined by amended Claim 9 and new Claim 40. In other words, the crayon is clearly distinguished from the composition of the claimed invention.

The mixture consisting of “ethylene glycol monobutyl ether” and “dipropylene glycol monomethyl ether” is disclosed in Comparative Example 1 and 2 of Fukuo. However, the mixture is no longer included in the claimed invention.

Fukuo also discloses a mixture of “propylene glycol monomethyl ether” and “dipropylene glycol monomethyl ether” as the essential component in Claim 1. However, the mixture consisting of the two solvents is no longer a mixture of the claimed invention.

In addition, Fukuo fails to mention wet-surface writing properties. Regarding the objectives, Fukuo merely teach that “It is a primary object of the present invention to provide a crayon which can fulfill higher safety criteria and which is superior in both writability and adhesion.” (See Fukuo column 1, lines 45-47). As to the writability, Fukuo does not aim at wet-surface. (See Fukuo column 6, lines 3-9).

Thus, Fukuo does not disclose or even suggest a solid composition which contains a mixture of at least two different specific solvents as presently claimed. Unlike what is stated in Fukuo, the compositions of the presently claimed invention can achieve excellent wet-surface writing properties. Therefore, Fukuo does not anticipate or make obvious the claimed invention and the claims should be allowed.

Novelty and Non-Obviousness over Okuda et al (U.S.4,829,108)

The office has rejected claims 9, 12-17, 22 and 39 under 35 USC 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Okuda et al. (U.S. 4,829,108). The rule according to MPEP 2131 is that to anticipate a claim, the reference must teach every element of the claim. Okuda merely discloses the use of a single solvent. In fact,

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ethylene glycol monobutyl ether (Example 1), ethylene glycol monobutyl ether (Example 2), ethylene glycol monoethyl ether acetate (Example 3), and ethylene glycol monoethyl ether acetate (Example 4) are used, respectively.

Moreover, there is nothing in Okuda about wet-surface writing properties. The object of Okuda is to provide a solid coating composition which can obviate the drawbacks of the prior art techniques (*see* Okuda column 1, lines 20-46).

Thus, Okuda fails to teach or suggest a solid composition which contains a mixture of at least two different specific solvents as claimed, and furthermore does not suggest a property achieved by such compositions, namely excellent wet-surface writing properties.

Those skilled in the art would not expect the use of a mixture of at least two different specific solvents defined by amended Claims 9 and new Claim 40 and the advantages realized thereby from Fukuo and Okuda which do not disclose or suggest the mixture. Therefore, the present invention is patentable over Fukuo and Okuda.

Applicant respectfully requests that all rejections be withdrawn and the claims be allowed.

Respectfully submitted,

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